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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

T/Brief
12/20/02

In Re Application of:

Robert W. Luffel, *et al.*

Serial No.: 09/337,802

Filing Date: June 22, 1999

Title: APPARATUS FOR TRANSLATING
A CARTRIDGE ACCESS DEVICE

Attorney Dkt.: HP 10980296-1

Examiner: D. Davis

Group Art Unit: 2652

Confirmation No.: 9485

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To: Assistant Commissioner for Patents
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Washington, D.C. 20231

I hereby certify that the foregoing **Transmittal of Reply Brief; Appellants' Reply Brief (in triplicate); and post cards for return by the United States Patent and Trademark Office;** are all being deposited with the United States Postal Service addressed to the Assistant Commissioner for Patents, Box AF, Washington, D.C. 20231, via Express Mail No. EV 156182559 US, on this 12th day of December, 2002.

Bruce E. Dahl, Registration No. 33,670

HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10980296-1



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Inventor(s): Robert W. Luffel, et al.

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COMMISSIONER FOR PATENTS
Washington, D.C. 20231

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TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith in *triplicate* is the Reply Brief with respect to the Examiner's Answer mailed on 10-18-2002. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

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Typed Name: Bruce E. Dahl, Reg. No. 33,670

Signature: Bruce E. Dahl

Respectfully submitted,

Robert W. Luffel, et al.

By Bruce E. Dahl

Bruce E. Dahl

Attorney/Agent for Applicant(s)

Reg. No. 33,670

Date: 12-12-2002

Telephone No.: (303) 291-3200

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Sir:

RESPONSE TO EXAMINER'S ANSWER

In section 7, the examiner confirmed that appellants' brief includes a statement that claims 1, 3-7, 12-19, and 24 do not stand for fall together and that appellants' brief meets the requirements of 37 C.F.R. 1.192(c)(7) and (c)(8).

Section 11 of the Examiner's Answer sets forth the examiner's response to the arguments made by the appellants in the Appeal Brief. Appellants reply to the examiner's responses in the order presented in the Examiner's Answer.

On pages 4 and 5 of the Answer, the examiner maintains that the term “integral” as used in the claims is not restricted to a one-piece article. The examiner’ cites several CCPA cases and even to Webster’s dictionary in an effort to support his conclusion. The examiner’s arguments are contrary to the law of claim construction.

The Court of Appeals for the Federal Circuit has ruled that the inventor’s definition and explanation of the meaning of a word, as evidenced by the specification, controls the interpretation of that claim term, even over a dictionary definition. See, *Serrano v. Telular Corp.*, 111 F.3d 1578, 42 USPQ2d 1538 (Fed. Cir. 1997): “Serrano’s proposed dictionary definition thus is inconsistent with the specification.” *Serrano, supra*, at 1582. The term “integral,” as used in the currently-pending claims means that the guide member is formed from the same member as the gear rack. This arrangement is shown in the drawings and is discussed at length in the specification. See, for example, page 21 of appellants’ Appeal Brief. The examiner’s re-definition of the term “integral” to mean something other than the meaning assigned to it by the inventor is contrary to *Serrano, supra*, and thus cannot be used to support the examiner’s rejections.

Even if it were proper to turn to judicial rulings (or a dictionary) for a definition of the term “integral,” which it is not (where, as here, the specification clearly provides the basis for the meaning of the term), appellants would refer the Board to *Mahurkar v. Arrow International, Inc.*, 160 F.Supp2d 927 (N.D.Ill. 2001), where the court found that: “[i]ntegral means one-piece formation, as opposed to bonded, which is a two-piece construction.” See *Mahurkar, supra*, at 943. Significantly, the court reached this conclusion after applying the test set forth in *Serrano, supra*. That is, the court found that “[t]he patent, the prosecution history and the common usage of the terms all suggest “integral” means being formed from one piece of material. . .” *Mahurkar, supra*, at 943.

Because each of the currently-pending claims requires at least a guide member that is integral with a gear rack, the term integral meaning formed from a single piece, and because Tadokoro discloses *separate* gear racks 32 and guide members 8, Tadokoro cannot anticipate any of the currently-pending claims as a matter of law.

Turning now to the examiner's reasons for rejecting dependent claim 3, the examiner argues that the wheel disclosed in Tadokoro is the same as the sliding bearing arrangement described by claim 3. More specifically, claim 3 requires that the first elongate guide member comprise "first and second opposed bearing surfaces. . . wherein said first bearing mounted to the cartridge access device *slidably engages* the first and second opposed bearing surfaces. . . ." In Tadokoro, the vertical guide member is guided along the guide member 8 by wheels 33. Therefore, the examiner's argument is erroneous on its face because a wheel is not a bearing that "slidably engages." Thus, Tadokoro cannot anticipate claim 3.

Perhaps in an attempt to buttress his position, the examiner cites to the dictionary meaning of the term "slide" in a contorted effort to say that a wheel moves "over a surface while maintaining smooth, continuous contact." This argument fails on two grounds. First, a rolling wheel does not maintain "continuous contact" with a surface. Rather, a new portion of the outer periphery of the wheel is brought into contact with the surface as the wheel rolls. Stated another way, no single point on the outer periphery of a wheel maintains "continuous contact" with the surface (unless the wheel is skidding without rolling). Any given point on the outer periphery of the wheel only contacts the surface once for each revolution of the wheel, which represents a distance along the surface of π multiplied by the diameter of the wheel. Clearly, any given point on the outer periphery of a wheel does not make "continuous contact" with the surface.

The second ground on which the examiner's argument fails is that for a wheel to make "continuous contact" with the surface, as required by the examiner's definition of "slide," requires that the wheel skid along the surface without rolling. However, the intended use of a wheel (including Tadokoro's wheel 33) is that it roll, not skid. By arguing that Tadokoro's wheel 33 meets the dictionary definition of "slide," the examiner requires Tadokoro's wheel 33 to be non-functional for its intended purpose. This cannot serve as a basis for rejecting claim 3 under Section 102.

In summation, the examiner's arguments, if affirmed by the Board, would lead to the absurd conclusion that a wheel is really the same thing as a bearing that "slidably engages," or that Tadokoro's

wheel be regarded as non-functional for its intended use, i.e., that it always skid over the surface and never roll. Neither conclusion can be used to support an anticipation rejection.

The next argument made by the examiner relates to claim 6. First, the examiner argues that claim 6 does not “require guidance.” This is false. Claim 6 recites the translation apparatus as defined by claim 5, further comprising a “third bearing mounted to the cartridge access device, said third bearing *contacting* said first elongate gear rack.” The effect of the third bearing in contacting the first elongate gear rack is to guide the cartridge access device along the displacement path. Perhaps concluding that the Board would not be persuaded by this argument, the examiner goes on to state that even if claim 6 requires guidance, Tadokoro’s gear is really a bearing, thus anticipates claim 6. Of course, a gear is not a bearing. Moreover, if the examiner’s argument is to be adopted, then Tadokoro’s guide 8 and wheel 33 (which do provide Tadokoro’s guidance function) would be entirely superfluous. That is, if Tadokoro’s rack and pinion drive system really provided a guidance function (according to the examiner a gear is a bearing), there would be no need for Tadokoro to provide a guide 8 and wheel 33. The correct interpretation (i.e., the one that does not render superfluous Tadokoro’s guide 8 and wheel 33) is that Tadokoro’s rack and pinion drive system *does not* provide a guidance function. Because Tadokoro does not meet the limitations of claim 6, Tadokoro cannot anticipate claim 6.

Lastly, in arguing for the propriety of his rejection of claim 12 the examiner states that “appellants did not claim require [sic] direct attachment of the worm and worm gear.” This statement is false. Claim 12 specifically requires “a motor. . . a worm *attached to the shaft of the motor* and a worm gear operatively connected to said first and second drive pinions. . .” Thus, in making his rejection the examiner ignores a specific limitation of claim 12. In addition, the examiner’s argument is also based on the erroneous conclusion that Tadokoro discloses a worm and worm gear drive arrangement. Tadokoro does not. Instead, Tadokoro discloses a motor 34 that drives the pinions 41 via sprockets 35, 37 and a drive belt 36. See Figure 20 of Tadokoro. Because Tadokoro’s sprocket and drive belt arrangement is not a worm and worm gear, Tadokoro cannot anticipate claim 12.

CONCLUSION

Tadokoro fails to disclose the elements and limitations that are specifically set forth in the currently-pending claims. Therefore, Tadokoro cannot be used to establish the required *prima-facie* case of anticipation under Section 102. Accordingly, appellants request the Board to reverse the rejections of claims 1, 3-7, 12-19, and 24.

Respectfully submitted,

DAHL & OSTERLOTH, L.L.P.

By: 

Bruce E. Dahl

Registration No. 33,670
555 Seventeenth Street, Suite 3405
Denver, CO 80202-3937
(303) 291-3200

Date: 12-12-02